

REMARKS

Claims 36, 38-48, 50-59, 61-65, and 67-73 are pending in the present application. Claims 48-58 and 59 were amended without narrowing or broadening the claims. Pursuant to 37 CFR §116, the amendments to Claims 48-58 and 59 reduce issues for appeal and do not touch the merits. Thus, entry of these amendments is respectfully requested since no further consideration or search is necessary. No new matter has been added. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following discussion.

Telephone Discussion

Applicant thanks the Examiner for the courtesies extended during the telephonic discussion of November 20, 2007 between Examiner Aung T. Win and Applicant's representative Sanders N. Hillis (reg. no. 45,712) in which the priority issue raised in the office action, and the 35 U.S.C. §101 rejection of claims 48-58 were discussed. During the discussion, the Examiner clarified that he did not believe all the subject matter of the present application was entitled to the priority date. In addition, the Examiner indicated that the preamble of Claims 48-58 should be modified to comply with 35 U.S.C. §101. The Examiner further described his objection to the term "that" in Claim 59 and elimination of the term was discussed. Further, amendments to claims 48-58 and 59 in an after final response were discussed, and it was agreed that such amendments would not narrow or enlarge the scope of the claims and thus would likely be entered.

Information Disclosure Statement

An Information Disclosure Statement was filed on November 13, 2006, together with a PTO Form 1449 listing the references cited therein. We have received an initialed copy of the PTO Form 1449. However, U.S. Patent No. 7,020,251 was not initialed as having been considered by the Examiner. Applicant respectfully requests a copy of the PTO Form 1449 with initials next to U.S. Patent No. 7,020,251 to confirm that U.S. Patent No. 7,020,251 has been considered and made of record in the case.

Claim rejections pursuant to 35 U.S.C. § 112 first paragraph and second paragraph

Claims 71 and 72 were rejected pursuant to 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. Specifically, the Examiner could not find support in the specification for the limitations "transmitting the voice-based response and the text-based response sequentially" as recited in Claim 71 and "accessing a database to determine a format of the response that is compatible with the wireless terminal" as described in Claim 72.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. (MPEP 2163(1))

With regard to Claim 71, at least paragraph [036] of the specification describes that "The multi-modal messaging system 10 discloses methods of using multiple modes of communication between a respective remote terminal 14 and a respective multi-modal message server 20 during a single interaction, thereby allowing the multi-modal message server 20 to respond to the demands of the user using both voice and text-based messages, for example." In addition at least paragraph [037] of the specification describes "As such, in these examples, the multi-modal

messaging system 10 is designed to provide the wireless terminal 14 with text-based messages that are responsive to the requests for information after the wireless telephone call has been disconnected and the user has already received the voice-based messages that are responsive to the requests for information."

Thus, in view of at least paragraphs [036] and [037] of Applicant's specification, the limitations "transmitting the voice-based response and the text-based response sequentially" as recited in Claim 71 are described in the specification in sufficient detail that one skilled in the art could reasonably conclude that the inventor had possession of the claimed invention.

With regard to Claim 72, at least paragraph [045] describes "In addition, the virtual customer database 32 may include customer data that includes information about the wireless terminal 14 that the user is using such as limitations for the amount or type of data content that the wireless terminal 14 can receive or the type of display used by the wireless terminal 14 so that responses can be structured in a format that is compatible with the display." Thus, in view of at least paragraph [045] of Applicant's specification, the limitations "accessing a database to determine a format of the response that is compatible with the wireless terminal" as recited in Claim 72 are described in the specification in sufficient detail that one skilled in the art could reasonably conclude that the inventor had possession of the claimed invention.

Claim 56 was rejected pursuant to 35 U.S.C. § 112 first paragraph as being indefinite for lacking antecedent basis for the terms "that information." Applicant respectfully traverses this assertion because in the context of Claim 59, "...configured to generate a response for the wireless terminal that includes only *that information* from the information item that is specified by a user...", the meaning of the terms "that information" is clear. (*emphasis added*) "A claim is indefinite when it contains words or phrases whose meaning is unclear." MPEP 2173.05(e) In

addition, MPEP 2173.05(e) indicates a lack of clarity could arise when "it would be unclear as to what element the limitation was making reference." Applicant respectfully asserts that is quite clear what the terms "that information" are referring to in Claim 59. Nonetheless, in the interest of efficient prosecution, and because an amendment to Claim 59 to eliminate the word "that" neither enlarges or reduces the scope of Claim 59, Applicant has so amended Claim 59. Entry of the amendment to Claim 59 is respectfully requested pursuant to 37 CFR §1.116 since the amendment places the claim in better form for appeal, does not touch the merits of the claims, and does not trigger any additional search or consideration of Claim 59.

For at least the foregoing reasons, Claims 71 and 72 and amended Claim 59 are supported by the specification, and are clear and definite. Thus, Applicant respectfully requests withdrawal of the 35 U.S.C. §112 first and second paragraph rejections of these claims.

Claim rejections pursuant to 35 U.S.C. § 103(a)

Claims 36, 38, 44-45, 47-48, 50, 56, 58-59, 61, 65, 67-70 and 73 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,449,344 to Goldfinger et al. (hereinafter referred to as "Goldfinger"), U.S. Patent Publication No. 20030078034A1 to Tsutsumi et al. (hereinafter referred to as "Tsutsumi"), in view of and further in view of U.S. Patent No. 6,546,005 to Berkley et al. (hereinafter referred to as "Berkley"). Also, Claims 39, 43, 46, 51, 54, 62, 63 and 71 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, and further in view of U.S. Patent No. 7,003,082 to Engelke et al. (hereinafter referred to as "Engelke"). Further, Claims 41, 52, 55, 57 and 64 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, and further in view of U.S. Patent Publication

No. 20020055351A1 to Elsey et al. (hereinafter referred to as "Elsey"). In addition, Claims 42 and 53 were rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, and further in view of U.S. Patent No. 6,345,245 to Sugiyama et al. (hereinafter referred to as "Sugiyama"). Also, Claim 72 rejected pursuant to 35 U.S.C. §103(a) as being unpatentable over Goldfinger, in view of Tsutsumi, in view of Berkley, and further in view of U.S. Patent Publication No. 20050020250A1 to Chadda et al. (hereinafter referred to as "Chadda"). Applicant respectfully traverses these rejections since all of the cited references are not prior art to the present application.

The present application claims priority from, and is a continuation-in-part of, U.S. Application Serial No. 10/263,523, filed October 3, 2002 entitled Multi-Modal Messaging, which claims priority from U.S. Application Serial No. 60/326,835 and U.S. Application Serial No. 10/264,219, filed October 3, 2002 entitled Virtual Customer Database, which claims priority from U.S. Application Serial No. 60/326,827.

On page 6 of the office action it was asserted that "Tsutsumi discloses the attribute adding program to indicate only information that is identified by a user of the wireless communication terminal as permissible to share with other wireless terminal [0038, 0039 & 0047]." Tsutsumi has been used in combination with other references in each rejection. Tsutsumi was filed in the United States on October 21, 2002, which is after the filing date of U.S. Application Serial No. 10/264,219, filed October 3, 2002 entitled Virtual Customer Database (the '219 application), from which the present application takes priority.

In paragraph [096] of the present application and corresponding paragraph [0055] of the publication of the '219 application, it is recited that "[a]s previously discussed requests originating from consumers may be addressed by the pull services of the VCDB system 10

(FIG. 1). Consumers may initiate requests via an electronic communication channel using for example a wireless communication device." In addition, in paragraph [075] of the present application and corresponding paragraph [032] of the publication of the '219 application (U.S. Patent Publication No. 2003/0065620A), it is described that "[v]erification of consent by the consumer, and/or the participating businesses 12, to the release and use of consumer/customer information that may be needed to process requests may be provided by the consumer verification data." In addition, paragraph [0102] of the present application and corresponding paragraph [0061] of the publication of the '219 application describe that "[d]etermination of the authorization level may involve verification of consent for the release and use of any customer information that may be needed to process and provide a response to the request." Thus, "the response including only information from the information record that is identified by a user of the subscriber terminal as permissible to sent to the wireless terminal" as described in Claim 36 is supported by the '219 application in at least the sections described above. Accordingly, the recited portions of Tsutsumi are not prior art to the present application in view of the corresponding disclosure in the priority document ('219 application). Since the applied prior art does not disclose or suggest all of the claimed limitations, it can not render obvious independent claim 36 for at least this reason.

On page 7 of the office action it was asserted that independent Claim 48 was "rejected for the same reason as stated above in Claim 1." Also, it was asserted that independent Claim 59 was "rejected for the same reason as the rejections stated above because (sic) executed steps by claimed means substantially close to the corresponding steps of Claim 1." As such, the recited portions of Tsutsumi are not prior art to Claims 48 or 59 for at least these reasons. (It is to be noted that Applicant has assumed that the references to "Claim 1" are actually references to

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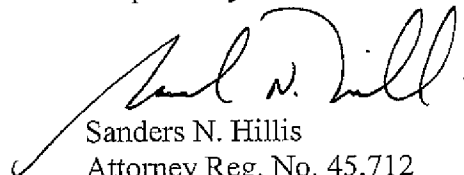
Filed: January 2, 2004

pending Claim 36 since Claim 1 is no longer pending in this case. If these statements are not meant to refer to Claim 36, Applicant respectfully requests issuance of an office action with the correctly cited Claim(s) and opportunity to further respond.) Further, all of the presently dependent claims were rejected relying on the cited portions of Tsutsumi, which are not prior art.

Since the cited portions of Tsutsumi are not prior art to the presently pending claims, for at least this reason the remaining references cited in the rejections alone or in combination do not teach, suggest disclose, or render obvious, each and every limitation of presently pending Claims 36, 38-48, 50-59, 61-65, and 67-73. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections of these claims.

For at least the foregoing reasons, independent Claims 36, 48 and 59, and the claims dependent therefrom are patentable over the cited combination of references. Thus, Applicant respectfully requests the issuance of a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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